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BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

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Technology Center 2100

Application Number: 09/774,008
Filing Date: January 31, 2001
Appellant(s): SHIN, SANG-HYUN

Mr. Seok-Won Stuart Lee
For Appellant

EXAMINER'S ANSWER

This is in response to the appeal brief filed 07/26/2007 appealing from the Office action mailed 08/25/2006.

(1) Real Party in Interest

A statement identifying by name the real party in interest is contained in the brief.

(2) Related Appeals and Interferences

The examiner is not aware of any related appeals, interferences, or judicial proceedings which will directly affect or be directly affected by or have a bearing on the Board's decision in the pending appeal.

(3) Status of Claims

The statement of the status of claims contained in the brief is correct.

(4) Status of Amendments After Final

The appellant's statement of the status of amendments after final rejection contained in the brief is correct.

(5) Summary of Claimed Subject Matter

The summary of claimed subject matter contained in the brief is correct.

(6) Grounds of Rejection to be Reviewed on Appeal

The appellant's statement of the grounds of rejection to be reviewed on appeal is correct.

(7) Claims Appendix

The copy of the appealed claims contained in the Appendix to the brief is correct.

(8) Evidence Relied Upon

Mendiola et al. US 2002/0006803 A1

(9) Grounds of Rejection

The following ground(s) of rejection are applicable to the appealed claims:

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless-

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

Claims 1-9, 12, 15-18 are rejected under 35 U.S.C. 102(e) as being anticipated by Mendiola et al. (hereinafter Mendiola)(US 2002/0006803 A1).

Referring to claim 1,

Mendiola teaches a method of performing an Internet protocol (IP)-based communication between wireless terminals (para. [0096] It should be noted that although the message dispatcher sends the notification back to the prospective user as an email message, it is designed to send the notification back through any access media permitted by the IM system and nominated by the prospective user, e.g. PC client application, GSM mobile phone internet browser client application, as well as email application.”), the method comprising the steps of:

(a) receiving a request for an IP address of a second terminal from a first terminal; (para. [0111] It should be noted that a peculiar situation arises when an electronic invitation is sent to a prospective email-based client by a GSM client. Moreover, using a UIN as the primary means of addressing messages is essential to the efficient exchange of messages between these two client types. As previously

described, GSM clients primarily send instant messages by directing them to numeric addresses or GSM mobile phone numbers, not alphanumeric names. In the light of this, it is necessary for GSM clients to embed the email address of the target recipient in the message containing the invitation and route it via the IM server for delivery to the email client. In order to do this, the message is sent to a universal access number, as defined by the carrier, for the processing of email-targeted messages." And para.[0015])

(b) upon receipt of the request, checking whether an (IP) address corresponding to the second terminal is registered, and (c) if the IP address is not registered, assigning an IP address to the second terminal corresponding to information from an IP address server (para.[0107] [0107] Thus existing members of the IM community can send an invitation to a prospective member to join the community by triggering the IM system server. The invitation is in electronic form and may come from any type of client insofar as the present mode is concerned, eg an SMS message from a OSM device, an internet signal from a PC-based or internet browser-based client application, or a regular e-mail message., and [0109], Once triggered, the IM system server sends an invitation to a target new user in the form of an e-mail message. Before sending the e-mail invitation, the IM system server invokes the registration handler to tentatively register the prospective user. In so doing, as previously described, the registration handler invokes the UIN assigner to assign a new UIN to the target user's e-mail address." And Fig. 4, para.[0113]-0123],

wherein the first terminal is a first wireless terminal and the second terminal is a second wireless terminal. ([0054] As shown, a GSM client 11 is connected via a

wireless communication medium involving cellular telecommunication sites 13 to a GSM carrier network 15. The GSM carrier network 15 is turn connected via a direct electronic link or the internet 17, to the IM server 19 of the IM system. It is important to have a direct electronic or internet link 17 between the GSM carrier network 15 and the IM server 19 in order to complete the IM system. [0055] Within the GSM carrier network 15, or more precisely the SMSC or message server system 21 thereof, a numeric "access code" must be defined which essentially directs important information contained in an SMS message sourced by the GSM client 11 to the IM server 19. [0056] The information contained in the SMS message that is of importance to the IM system includes the following: [0057] the mobile number 23 of the sender, [0058] the text of the SMS message 25, and [0059] the numeric address 27 of the recipient."

Referring to claim 2,

Mendiola teaches the method of claim 1, wherein in the step (a), the request for an IP address is made using a telephone number, and wherein in the step (b), checking whether an IP address corresponds to the second terminal is carried out by checking whether the telephone number corresponds to the second terminal. ([0054] As shown, a GSM client 11 is connected via a wireless communication medium involving cellular telecommunication sites 13 to a GSM carrier network 15. The GSM carrier network 15 is turn connected via a direct electronic link or the internet 17, to the IM server 19 of the IM system. It is important to have a direct electronic or internet link 17 between the GSM carrier network 15 and the IM server 19 in order to complete the IM system. [0055] Within the GSM carrier network 15, or more precisely the SMSC or message server

system 21 thereof, a numeric "access code" must be defined which essentially directs important information contained in an SMS message sourced by the GSM client 11 to the IM server 19. [0056] The information contained in the SMS message that is of importance to the IM system includes the following: [0057] the mobile number 23 of the sender, [0058] the text of the SMS message 25, and [0059] the numeric address 27 of the recipient.")

Referring to claim 3,

Mendiola teaches the method of claim 1, further comprising the step of sending a notice requesting the second terminal to establish an IP connection if the IP address is not registered. ([0116] Step 2; IM server system assigns a UIN to the target new user and email address of target new user [0117] The registration handler 119 of the IM server system 113 causes the UIN assigner to generate a UIN to be assigned and matched to John Smith's email address in the manner previously described. For this illustration, UIN 12125556666 is matched to johnsmith@company.com and is assigned to John Smith as his unique ID for the purpose of handling messages by the IM server system. This mapping will be stored 121 in the user database 123 for future use 125.[0118] Step 3: Message is sent to the target new user. [0119] The IM server sends an email 129 to the prospective user John Smith 127 at johnsmith@company.com. The message is an invitation by Dennis for John to be a member of the IM community and an authorized "buddy" of Dennis. Detailed and additional instructions on how to complete the registration process are contained in the body 131 of the message. The subject 133 of the email contains such information John's UIN (e.g., 12125556666) and

temporary password. The message 129 also gives the option for John to download the PC-based application with which John Smith can also use to complete the optional registration procedure. For the purposes of this illustration, the "From" email address is 639175336647@Chikka.com. The user ID portion of this email address is the UIN of Dennis. (The "From" address can also be some other address that is directed to the IM server system, which if sent there, the IM system server would be able to process accordingly for the purpose of completing John Smith's registration.) In the present example, the email 129 is routed via John's company's email system 135 which includes a SMTP server 137 and a POP/IMAP server 139.")

Referring to claim 4,

Mendiola teaches the method of claim 3, wherein in the step of sending a notice requesting the second terminal to establish an IP connection, said notice is sent using a Short Message Service (SMS). ([0123] Message exchange with GSM clients will in particular be as easy as the GSM client user sending an SMS message to a numeric address consisting of the GSM carrier "access code" plus the UIN.)

Referring to claim 5,

Mendiola teaches the method of claim 1, wherein if the IP address is registered, further comprising the step of transmitting the IP address to one of a plurality of terminals, said plurality of terminals including said first terminal.([0121] John Smith agrees to join the IM community by simply replying 141 to the email message. This action immediately prompts the IM server system 113 that John Smith has agreed to join the IM community and that he has authorized Dennis to be included in his "buddy"

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list; hence, John Smith can receive instant messages from Dennis and Dennis can be notified of John's "online" status.)

Referring to claim 6,

Mendiola teaches the method of claim 5, wherein the IP address is transmitted to said one of a plurality of terminals using transmission control protocol/internet protocol (TCP/IP) or user datagram protocol/internet protocol (UDP/IP). (para. [0096] It should be noted that although the message dispatcher sends the notification back to the prospective user as an email message, it is designed to send the notification back through any access media permitted by the IM system and nominated by the prospective user, e.g. PC client application, GSM mobile phone internet browser client application, as well as email application.").

Referring to claim 7,

Mendiola teaches communication system having a first wireless terminal and a second wireless terminal (para. [0096] It should be noted that although the message dispatcher sends the notification back to the prospective user as an email message, it is designed to send the notification back through any access media permitted by the IM system and nominated by the prospective user, e.g. PC client application, GSM mobile phone internet browser client application, as well as email application."),, an internet protocol (IP) address server, and a name server for providing an IP address at the request of the first wireless terminal, wherein the name server ([0030] Preferably, said client types connected to the computer network via the GSM network have SMS capability and are initially connected via an SMSC server to control and manage said

SMS therebetween, and wherein said SMSC server is directly connected to said IM server via said computer network. In accordance with another aspect of the present invention, there is provided a system for assigning a unique identifier to a prospective user of an instant messaging system comprising a plurality of clients having IM applications of the same or different types, selectively interconnected to an IM server by way of a computer network,") comprises:

a database for storing IP addresses corresponding to telephone numbers of a plurality of terminals, said plurality of terminals including the second wireless terminal ([0034] database means for storing the matched unique identifier and client specific access address under the unique identifier); and

a controller which assigns an IP address to the second wireless terminal corresponding to information from the IP address server, if the IP address of the second wireless terminal that is requested by the first wireless terminal using a telephone number is not registered, and registers the assigned IP address in the database.([0031] a registration handling means for receiving a client specific access address of a prospective user on the computer network together with a request to register or tentatively register said prospective user; [0032] a unique identifier assigning means to automatically allocate said unique identifier to said prospective user and match said unique identifier to the client specific address of the prospective user; [0033] account processing means to register or tentatively register an account for said prospective user; [0035] a message dispatching means for sending notification of said unique identifier to said prospective user at the client specific address of the prospective user,

either: confirming the registering of the prospective user if the initial sending was associated with a direct request to register from the prospective user; or inviting registration of the prospective user if the initial sending was associated with a request to register from someone other than the prospective user.)

Referring to claim 8,

Mendiola teaches a name server in an internet protocol (IP)-based communication system comprising: a communication module unit for sending and receiving IP-based data; a controller for registering telephone numbers and requests for translation of wireless telephone numbers into IP addresses; and a database for storing IP addresses and wireless telephone numbers as determined by the controller, wherein the communication module unit sends and receives IP-based data to and from external devices and the external devices include IP address servers. ([0030] Preferably, said client types connected to the computer network via the GSM network have SMS capability and are initially connected via an SMSC server to control and manage said SMS therebetween, and wherein said SMSC server is directly connected to said IM server via said computer network. In accordance with another aspect of the present invention, there is provided a system for assigning a unique identifier to a prospective user of an instant messaging system comprising a plurality of clients having IM applications of the same or different types, selectively interconnected to an IM server by way of a computer network, the system comprising: [0031] a registration handling means for receiving a client specific access address of a prospective user on the computer network together with a request to register or tentatively register said

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prospective user; 0032] a unique identifier assigning means to automatically allocate said unique identifier to said prospective user and match said unique identifier to the client specific address of the prospective user; [0033] account processing means to register or tentatively register an account for said prospective user; [0034] database means for storing the matched unique identifier and client specific access address under the unique identifier; and [0035] a message dispatching means for sending notification of said unique identifier to said prospective user at the client specific address of the prospective user, either: confirming the registering of the prospective user if the initial sending was associated with a direct request to register from the prospective user; or inviting registration of the prospective user if the initial sending was associated with a request to register from someone other than the prospective user.)

Referring to claim 9,

Mendiola teaches the name server of claim 8, wherein the name server further comprises a memory for storing a program for operating the controller.([0035] a message dispatching means for sending notification of said unique identifier to said prospective user at the client specific address of the prospective user, either: confirming the registering of the prospective user if the initial sending was associated with a direct request to register from the prospective user; or inviting registration of the prospective user if the initial sending was associated with a request to register from someone other than the prospective user.)

Referring to claim 12,

Mendiola teaches the name server of claim 8, wherein the controller receives requests for translation of telephone numbers into IP addresses from the communication module unit. ([0034] database means for storing the matched unique identifier and client specific access address under the unique identifier)

Referring to claim 15,

Mendiola teaches the communication system of claim 7 further comprising a communication module unit which sends the assigned IP address to the first wireless terminal. 0121] John Smith agrees to join the IM community by simply replying 141 to the email message. This action immediately prompts the IM server system 113 that John Smith has agreed to join the IM community and that he has authorized Dennis to be included in his "buddy" list; hence, John Smith can receive instant messages from Dennis and Dennis can be notified of John's "online" status.)

Referring to claim 16,

Mendiola teaches the communication system of claim 7, wherein said name server receives a request for the IP address of the second wireless terminal from the first wireless terminal. (para. [0111] It should be noted that a peculiar situation arises when an electronic invitation is sent to a prospective email-based client by a GSM client. Moreover, using a UIN as the primary means of addressing messages is essential to the efficient exchange of messages between these two client types. As previously described, GSM clients primarily send instant messages by directing them to numeric addresses or GSM mobile phone numbers, not alphanumeric names. In the light of this, it is necessary for GSM clients to embed the email address of the target

recipient in the message containing the invitation and route it via the IM server for delivery to the email client. In order to do this, the message is sent to a universal access number, as defined by the carrier, for the processing of email-targeted messages." And para.[0015])

(b) upon receipt of the request, checking whether an (IP) address corresponding to the second terminal is registered, and (c) if the IP address is not registered, assigning an IP address to the second terminal corresponding to information from an IP address server (para.[0107] [0107] Thus existing members of the IM community can send an invitation to a prospective member to join the community by triggering the IM system server. The invitation is in electronic form and may come from any type of client insofar as the present mode is concerned, eg an SMS message from a OSM device, an internet signal from a PC-based or internet browser-based client application, or a regular e-mail message., and [0109], Once triggered, the IM system server sends an invitation to a target new user in the form of an e-mail message. Before sending the e-mail invitation, the IM system server invokes the registration handler to tentatively register the prospective user. In so doing, as previously described, the registration handler invokes the UIN assigner to assign a new UIN to the target user's e-mail address." And Fig. 4, para.[0113]-0123]

Referring to claims 17 and 18,

Mendiola teaches method of claim 1, wherein the IP address corresponding to the second terminal or the IP address assigned to the second terminal is unique to the second terminal, and the method of claim 17, wherein the IP address corresponding to

the second terminal or the IP address assigned to the second terminal is transmitted to the first terminal. para. [0096], [0043], . [0123], Note: Therefore, the reference teaches that the IP addresses are being exchanged for the transmission of the Instant messages.

Examiner's note: Examiner has cited particular columns and line numbers in the references as applied to the claims above for the convenience of the applicant. Although the specified citations are representative of the teachings of the art and are applied to the specific limitations within the individual claim, other passages and figures may apply as well. It is respectfully requested from the applicant in preparing responses, to fully consider the references in entirety as potentially teaching all or part of the claimed invention, as well as the context of the passage as taught by the prior art or disclosed by the Examiner.

(10) Response to Argument

Appellant's argument (page 10 of Appeal brief)

"Applicant submits that the Examiner is incorrect in alleging that UIN of Mendiola discloses the IP address as recited in claim 1. First, the IP address recited in claim 1 refers to an Internet Protocol address. See Specification at page 5, lines 2-4. Therefore, the address complies with the Internet Protocol (see Specification at page 7, lines 7-11), whereas there is nothing in Mendiola which suggests that the UIN complies with the Internet Protocol. See paragraph 117 (UIN of "12125556666")."

Examiner's response:

Examiner would like to state the details of Applicant's Specification as indicated by the Applicant for the purpose of it's comparison with the teachings of Mendiola.

Applicant's Specification page 7, lines 7-11 and related Fig. 4 state the following:

"FIG. 4 shows an embodiment of the database 350 of FIG. 3. Referring to FIG. 4, the IP address for the telephone number "031-999- 1234" of the terminal 210 is registered as "167-234-34-123," whereas an IP address for the telephone number of the other terminal 270 is not registered."

FIG. 4

TELEPHONE NUMBER	IP ADDRESS
031-999-1234	167-234-34-123
031-234-4567	
031-345-5679	

Having learned what the Applicant's Specification states, the following is the teachings of Manidola:

Mendiola teaches at paragraph [0095], "[0095] Dennis is now a registered member of the IM community and can receive and send instant messages using his UIN 12125556666."

Please note that "12125556666" is an Unique Identifier and NOT a phone number.

Additionally, Mendiola states in paragraphs [0042] and [0043],

"[0042] The particular mode for carrying out the preferred embodiment of the invention is directed towards a system and a method for assigning a unique identifier to

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register or tentatively register a prospective user on an instant messaging "IM" system.

The IM system includes a plurality of existing users or clients having IM applications of the same or different types, and which are selectively interconnected to an IM server of the system by way of a computer network such as the internet or other electronic link or links.

"[0043] The types of clients that may be connected to such an IM system include: GSM mobile clients, PC-based clients, internet browser clients, and email clients. This is essentially made possible by the IM system having basic enabling functions residing within the IM server and by using a unique identifier in the form of a single Unique Identification Number ("UIN") for a user, regardless of the appliance or client type used by that user for accessing the IM server."

Thus, UIN assigned to GSM mobile clients (Wireless terminals) having IM applications of the same or different types, and which are selectively interconnected to an IM server of the system by way of a computer network such as the internet, facilitates the receipt and sending of instant messages.

Further, Mendiola discloses at paragraph [0110], "The UIN will then be the primary means of addressing instant messages intended for that new user. To send a message to the new user, all that the sender has to do is to specify the UIN of the intended party in the recipient's address field. The instant message will be sent accordingly, assuming the new user has permitted such. Users have the option of specifying how messages can be received, whether a message is sent to any

combination of the following access media: PC Client, GSM mobile phone, and email-based client.”

Thus, based on the comparison with the Applicant’s Specification and Mendiola’s teachings, UNI is an IP address assigned to GSM Mobile clients. Thereby Mendiola teaches “A method of performing an Internet protocol (IP)-based communication between wireless terminals.” and “wherein the first terminal is a first wireless terminal and the second terminal is a second wireless terminal.”

Appellant’s argument (pages 10 and 11 of Appeal brief)

“Even assuming arguendo, that the UIN corresponds to the claimed IP address, Applicant submits that Mendiola fails to disclose or suggest a method wherein (b) upon receipt of the request, checking whether an IP address corresponding to the second terminal is registered; and c) if the IP address is not registered, assigning an IP address to the second terminal corresponding to information from an IP address server, in combination with other elements of the claim.”

“In addition to the above, Applicant submits that if the IP address is not registered, claim 1 recites assigning an IP address to the second terminal corresponding to information from an IP address server. Thus, claim 1 requires a particular relationship between the claimed checking in (b) with the claimed assigning in (c), a relationship which is not found in Mendiola.

For at least the above reasons, claim 1 is patentable.”

Examiner’s response:

Mendiola teaches two scenarios in the following paragraph:

["0048] The difference between registration and tentative registration arises from whether the prospective user directly accesses the IM server in order to explicitly register an account (registration), or whether the prospective user is invited to register by an existing user, or the operator of the IM server itself (tentative registration)."

The scenario including "whether the prospective user is invited to register by an existing user" is of our interest.

This scenario is reiterated in paragraph [0079]:

"[0079] (ii) sending an electronic invitation by an existing IM user to the prospective e-mail-based user, inviting them to be a member of the IM community and/or an authorized buddy of that user;"

Thus "inviting the prospective user to register by an existing user at and through the IM server " is "(a) receiving a request for an IP address of a second terminal from a first terminal"

Mendiola teaches at para. [0106] and [109]:

"[0106] The second way of prompting the IM server as referred to in (ii) above, namely an electronic invitation by an existing IM user to be a member and/or be an authorized buddy is sent to the prospective e-mail-based user, is more indirect than the first way and involves initially creating a tentative registration."

[0109] Once triggered, the IM system server sends an invitation to a target new user in the form of an e-mail message. Before sending the e-mail invitation, the IM system server invokes the registration handler to tentatively register the prospective

user. In so doing, as previously described, the registration handler invokes the UIN assigner to assign a new UIN to the target user's e-mail address.

Thus, Mendiola teaches "assigning an IP address to the second terminal corresponding to information from an IP address server."

However, before assigning an IP address to the second terminal, Mendiola teaches the system of assigning a unique identifier to a prospective user of an instant messaging system in paragraphs [0030]-[0035]:

"[0030], "In accordance with another aspect of the present invention, there is provided a system for assigning a unique identifier to a prospective user of an instant messaging system comprising a plurality of clients having IM applications of the same or different types, selectively interconnected to an IM server by way of a computer network, the system comprising:

[0031] a registration handling means for receiving a client specific access address of a prospective user on the computer network together with a request to register or tentatively register said prospective user;

[0032] a unique identifier assigning means to automatically allocate said unique identifier to said prospective user and match said unique identifier to the client specific address of the prospective user;

[0033] account processing means to register or tentatively register an account for said prospective user;

[0034] database means for storing the matched unique identifier and client specific access address under the unique identifier; and

[0035] a message dispatching means for sending notification of said unique identifier to said prospective user at the client specific address of the prospective user, either: confirming the registering of the prospective user if the initial sending was associated with a direct request to register from the prospective user; or inviting registration of the prospective user if the initial sending was associated with a request to register from someone other than the prospective user."

Mendiola, thus,

1) "allocates" unique identifier to said prospective user and match said unique identifier to the client specific address of the prospective user;

2) tentatively register an account for said prospective user;

3) then stores in the database the matched unique identifier and client specific access address under the unique identifier;

4) sends notification of said unique identifier to said prospective user at the client specific address of the prospective user, inviting registration of the prospective user if the initial sending was associated with a request to register from someone other than the prospective user.

These steps for registration occurs before "assigning a unique identifier to a prospective user of an instant messaging system in a system for assigning a unique identifier to a prospective user of an instant messaging system.

Thus, Mendiola teaches (b) upon receipt of the request, checking whether an IP address corresponding to the second terminal is registered; and (c) if the IP address is

not registered, assigning an IP address to the second terminal corresponding to information from an IP address server.

Thus, claim 1 requiring a particular relationship between the claimed checking in (b) with the claimed assigning in (c), a relationship which is found in Mendiola.

Applicant's Argument:

"Claims 7 and 8 are patentable for reasons similar to those submitted for claim 1."

Examiner's response:

Please refer to the response provided for Claim 1.

(11) Related Proceeding(s) Appendix

No decision rendered by a court or the Board is identified by the Examiner in the Related Appeals and Interferences section of this Examiner's answer.

For the above reasons, it is believed that the rejections should be sustained.

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Respectfully submitted,



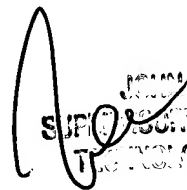
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